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OFFICE OF PETITIONS

In re Application of
Durbin, et al.
Application No. 09/681,017
Filed: November 22, 2000
Attorney Docket No. GEMS8081.023
For: METHOD AND SYSTEM TO REMOTELY
ENABLE SOFTWARE-BASED OPTIONS FOR
A TRIAL PERIOD

ON PETITION

This is a decision on the renewed petition, filed October 2, 2008, under 37 CFR 1.183 to waive the necessity for the signatures of all joint inventors on a 37 CFR 1.131 declaration, the renewed petition under 37 CFR 1.48(a) to correct the inventorship of the above-identified application by the addition of four joint inventors, and the renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(3), which requires submission of an oath or declaration signed by the actual inventors.

The petition under 37 CFR 1.183 to waive 37 CFR 1.131 is **dismissed**.

The petition under 37 CFR 1.48(a) is **dismissed**.

The petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(3) is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT. The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR §§ 1.48 and 1.183.

A declaration, filed on February 12, 2001, listed three joint inventors: Winnie Durbin, Kun Zhang, and Karamjeet Singh.

Petitioners wish to add David T. Mehring, Thomas L. Lamoureux, Hubert A. Zettel, and Timothy D. Butler as joint inventors.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition setting forth the desired change in inventorship, (2) including a statement from each person being added and from each person being deleted as an inventor that the error occurred

without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The petitions of record lack compliance with item (3). The declaration filed on May 12, 2008 lacks signatures from the original three joint inventors. Inventor Zhang's execution is excused because it has been established that he cannot be located. See petition decision, October 12, 2007, Page 1.

The petition under 37 CFR 1.183 requesting waiver of the execution of the declaration for patent application by Inventors Singh and Durbin is evaluated as to whether the non-signing inventors could not be reached. In essence, petitioners must show that the inability to again obtain an executed declaration from the non-signing inventors is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond their control.

Petitioners have not established that Inventors Singh and Durbin cannot be located. The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate non-signing Inventors Singh and Durbin, such that the declaration can be accepted. Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor.

Petitioners have not demonstrated that all efforts were expended in trying to locate the non-signing inventors. One returned mailing does not meet the required level of diligence that must be shown in order to obtain waiver of signature requirements.

Petitioners should engage in further efforts to locate Mr. Singh and Ms. Durbin. The following is a list of evidentiary sources that are commonly relied upon to prove inability to locate an inventor: searches of Internet databases; inquiries of local telephone directories; inquiries of former co-workers; E-mail; etc.. Every listed type of search need not be done. However, a diligent effort to find the inventors must be made.

Documentary evidence that supports a finding that the non-signing inventors could not be found or reached should be made part of any affidavits or declarations that fully describe the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventors. Printed computer records would suffice.

The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition requesting waiver under 37 CFR 1.183 of the requirement in 37 CFR 1.48(a)(3) for the execution of the new declaration for patent application by Inventors Singh and Durbin cannot be granted at this time. For this reason, the petition under 37 CFR 1.48(a) is dismissed, as well.

Petitioners assert that the three original joint inventors cannot be located to join in the execution of a declaration under 37 CFR 1.131. It has been established that Inventor Zhang cannot be located. However, as outlined above, petitioners have not established that Inventors Durbin and Singh cannot be located to execute the declaration under 37 CFR 1.131.

Further efforts to locate Mr. Singh and Ms. Durbin are required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3230.



Shirene Willis Brantley
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